

REMARKS

Reconsideration of this application is respectfully requested.

Claims 1, 5, 7, 8, 10, 11, 12, 13, and 15-62 are pending in this application, claims 3, 4, 6, 14, having been previously cancelled. Claims 15-18 and 23-59 have been withdrawn.

Points c) and d) of claims 1 and 7 have been deleted. Claim 9 has been merged into amended claim 8. Claims 2, 9, and 14 have been cancelled. Claim 62 has been added. The improper multiple dependencies of claims 19 to 22 and 60 have been corrected.

Allowable Subject Matter

Applicant courteously acknowledges the allowance of claim 61.

Claim 10 was objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claim 10 has been written in independent form. Thus, this claim should also be allowable.

Claim Objections

Claims 19-22 and 60 were objected to under 37 C.F.R. § 1.75(c) as being in improper form because a multiple dependent claim cannot depend from any other multiple dependent claim. See M.P.E.P. § 608.1(n). The claims recited dependency to claim 14, which is multiply dependent. This objection has been obviated by omitting reference to claim 14 in claims 19-22 and 60. Thus, this objection may be withdrawn.

Claim rejections under 35 U.S.C. § 102

Claims 1, 2, 5, 7-9, and 11-14 were rejected under 35 U.S.C. § 102(b) as being anticipated by Brennan (U.S. 5,474,795). With regard to claims 1, 2, and 7-9, the Examiner contends that Brennan teaches the production of a solid support comprising immobilized extendable oligonucleotides that represent every possible permutation of the 10-mer oligonucleotide. The Examiner concluded that the product of Brennan inherently contains oligonucleotides that possess 100% identity or homology to 10-mer segments of SEQ ID NO:1 and 4, as well as oligonucleotides that are perfectly complementary to 10-mer segments of SEQ ID NO:1 and 4. With regard to claims 5 and 11-14, the fragment obtained by amplification with primers, SEQ ID NO: 13-18, necessarily comprises a 10-mer that was present in the product according to Brennan. This ground for rejection is respectfully traversed and reconsideration is requested. Office Action at 4.

Brennan does not disclose the specific oligonucleotide sequences SEQ ID NO: 1 or SEQ ID NO:4, nor the sequences fully complementary thereto. Thus, pending claims 1 and 7, and claims that depend, therefrom are new and inventive over the cited documents.

Claims 1, 2, 5, 7-9, and 11-14 were also rejected under 35 U.S.C. § 102(b) as being anticipated by New England Biolabs 1998/99 Catalog (NEB Catalog). With regard to claims 1, 2, and 7-9, the Examiner contends that page 121 of the NEB Catalog discloses a packaged product for sale (catalog #1255) comprising Random Primer 24. According to the Examiner, this product comprised every possible primer of 24 bases in length, and therefore inherently anticipates the claimed invention. With regard to claims 5 and 11-14, the Examiner contends that the fragment obtained by amplification with primers, SEQ ID NO: 13-18, necessarily comprises a 24-mer that was

present in the product according to NEB. According to the Examiner, after 4 additional nucleotides are added to the 20-mer recited in SEQ ID NO:13, the amplicon necessarily comprises a 24-mer that was present in the product according to NEB. Office Action at 5-6. This ground for rejection is respectfully traversed and reconsideration is requested.

As with the Brennan reference, the NEB reference does not disclose the specific oligonucleotide sequences SED ID NO: 1 or SED ID NO:4, nor the sequences fully complementary thereto. Thus, pending claims 1 and 7, and claims that depend therefrom, are new and inventive over the cited documents. Accordingly, Applicant respectfully submits that these claims are allowable over the cited references.

Applicant respectfully requests that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 1, 5, 7, 8, 10-13, 19-22, and 60-62 in condition for allowance. Applicant submits that the proposed amendments of claims 1, 7, 8, 10, 19, and 21, and new claim 62, do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. Therefore, this Amendment should allow for immediate action by the Examiner.

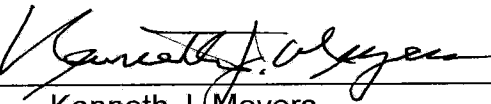
Finally, Applicant submits that the entry of the amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

Please grant any further extensions of time required to enter this paper and
charge any additional required fees to our Deposit Account No. 06-0916.

Dated: August 7, 2009

Respectfully submitted,

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